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10/681,724	10/08/2003	Robert H. Kummer JR.	F-725	6704

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Brian A. Lemm
Pitney Bowes Inc.
35 Waterview Drive
P.O. Box 3000
Shelton, CT 06484

EXAMINER

VETTER, DANIEL

ART UNIT PAPER NUMBER

3628

DATE MAILED: 11/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/681,724

Applicant(s)

KUMMER ET AL.

Examiner

Daniel P. Vetter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 and 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/8/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claims 1-23 are pending in this application.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10 and 21, drawn to a method for processing a mail piece, classified in class 705, subclass 401.
 - II. Claims 11-20, drawn to a mail processing system for processing a mail piece, classified in class 705, subclass 401.
 - III. Claims 22-23, drawn to a method for processing mail pieces, classified in class 705, subclass 410.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case Group I, the method for processing a mail piece can be practiced by another and materially different apparatus or by hand, rather than by the invention of Group II.

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3. Inventions III and I are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of Group III establishes a default class of service while the invention of Group I uses a first class of service supplied by a user and therefore are not usable together. Group III has a different design because it compares a default class rather than a class received from a user; Group III has a different mode of operation because it establishes threshold values to compare with the mail piece parameters; and Group III has a different effect because it uses a different class to process the mail piece rather than determining a postage amount for the mail piece.

4. Inventions III and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of Group III establishes a default class of service while the invention of Group II uses a first class of service supplied by a user and therefore are not usable together. Group III has a different design because it compares a default class rather than a class received from a user; Group III has a different mode of operation because it establishes threshold values to compare with the mail piece parameters; and Group III has a

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different effect because it uses a different class to process the mail piece rather than determining a postage amount for the mail piece.

5. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Brian Lemm on November 1, 2006 a provisional election was made without traverse to prosecute the invention of Group II, claims 11-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-10 and 21-23 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

8. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: S24. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

9. Claim 11 is objected to because of the following informalities: "said determined at least dimension" in line 13 appears to be a grammatical error. Examiner is

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interpreting this as "said determined at least one dimension." Appropriate correction is required.

10. Claim 19 is objected to because of the following informalities: "said determined t least one" in line 4 appears to be a spelling error. Examiner is interpreting this as "said determined at least one." Appropriate correction is required.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 12 and 14-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Claim 12 recites the limitation "one of said mail piece" in line 3. It is unclear if this limitation is introducing more mail pieces being processed by the system, and therefore makes the scope of the claim vague and indefinite.

14. Claims 14-17 contain the same deficiencies as claim 12 through dependency and, as such, are rejected for the same reasons.

15. Claim 14 recites the limitation "said special services" in line 3. There is insufficient antecedent basis for this limitation in the claim.

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16. Claims 15-17 contain the same deficiencies as claim 14 through dependency and, as such, are rejected for the same reasons.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulik, U. S. Pat. No. 5,842,186 (Reference AC of the IDS submitted on 10/08/2003) in view of Ramsden, et al., U.S. Pat. No. 5,831,220 (Reference A of the attached PTO-892).

19. As per claim 11, Kulik teaches a mail processing system for processing a mail piece comprising: a postage meter for applying postage values to said mail piece (column 5, line 15); a scale for weighing said mail piece (column 5, line 14); a central processing unit controlling operation of said postage meter and said scale (column 5, line 19-20); and a memory storing postage rating information (column 5, lines 21, 34-35) and software executable by said central processing unit (column 5, line 20), said software including instructions for performing: receiving a first class of service from a

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user for processing said mail piece (column 4, lines 58-59); determining a weight of said mail piece using said scale (column 4, lines 60-61); determining whether said first class of service is appropriate for said mail piece using said determined weight and other parameter (column 8, lines 38-41), and if said first class of service is not appropriate, determining a second class of service for said mail piece using said determined weight and other parameter (column 8, lines 41-44), said second class of service being appropriate for said mail piece (column 8, lines 41-44); setting a final class of service for said mail piece (column 8, line 40), said final class of service being said first class of service if said first class of service is determined to be appropriate and said second class of service if said first class of service is determined to not be appropriate (column 8, lines 38-44; column 7, lines 16-25); and determining a postage amount for said mail piece using said determined weight, at least one dimension, said final class of service and said postage rating information (column 5, lines 3-6; column 7, lines 50-53). Kulik does not teach a dimensioning module for determining at least one dimension of said mail piece, does not teach the central processing unit controlling said dimensioning module, and does not teach determining at least one dimension of said mail piece using said dimensioning module. Ramsden, et al. teaches a dimensioning module for determining at least one dimension of said mail piece (column 16, lines 1-3), the central processing unit controlling said dimensioning module (column 17, lines 20-21);

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determining at least one dimension of said mail piece using said dimensioning module (column 16, line 31). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate a dimensioning module for determining at least one dimension of said mail piece, the central processing unit controlling said dimensioning module; determining at least one dimension of said mail piece using said dimensioning module; into the system taught by Kulik because dimensions are used to determine postage charges (as taught by Ramsden, et al., column 2, lines 49-52).

20. As per claim 12, Kulik in view of Ramsden, et al. teaches the system of claim 11 as described above. Kulik further teaches the software further includes instructions for causing said postage meter to apply said determined postage amount to one of said mail piece or a tape to be applied to said mail piece (column 5, lines 28-33).

21. As per claim 13, Kulik in view of Ramsden, et al. teaches the system of claim 11 as described above. Ramsden, et al. further teaches receiving one or more special services to be applied to said mail piece (column 2, lines 54-55). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate receiving one or more special services to be applied to said mail piece into the system taught by Kulik in view of Ramsden, et al. because many deliverers offer

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special services for a premium price (as taught by Ramsden, et al., column 1, lines 31-32).

22. As per claim 14, Kulik in view of Ramsden, et al. teaches the system of claim 12 as described above. Ramsden further teaches determining whether each of said special services is applicable to said mail piece using said postage rating information, said postage rating information including special service availability information, and generating a list of applicable special services for said mail piece (column 2, lines 49-53). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate determining whether each of said special services is applicable to said mail piece using said postage rating information, said postage rating information including special service availability information, and generating a list of applicable special services for said mail piece into the system taught by Kulik in view of Ramsden, et al. because many deliverers offer special services for a premium price (as taught by Ramsden, et al., column 1, lines 31-32).

23. As per claim 15, Kulik in view of Ramsden, et al. teaches the system of claim 14 as described above. Kulik further teaches determining a postage amount for said mail piece using said determined weight, said determined at least one dimension, and said final class of service (column 5, lines 1-8). Kulik does not teach determining a postage amount for said mail piece using said list of applicable special services. Ramsden, et

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al. teaches determining a postage amount for said mail piece using said list of applicable special services (column 2, lines 52-53). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate determining a postage amount for said mail piece using said list of applicable special services into the system taught by Kulik in view of Ramsden, et al. because many deliverers offer special services for a premium price (as taught by Ramsden, et al., column 1, lines 31-32).

24. As per claim 16, Kulik in view of Ramsden, et al. teaches the system of claim 14 as described above. Ramsden, et al. further teaches determining whether each of said special services is applicable to said mail piece is based on said final class of service, said determined weight, said determined at least one dimension, and a determination as to whether all applicable prerequisite requirements have been satisfied (column 21, lines 6-14). Examiner is interpreting determining if a service option is "available" as determining whether all applicable prerequisite requirements have been satisfied. It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate determining whether each of said special services is applicable to said mail piece is based on said final class of service, said determined weight, said determined at least one dimension, and a determination as to whether all applicable prerequisite requirements have been satisfied into the system taught by Kulik in view of

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Ramsden, et al. because many deliverers offer special services for a premium price (as taught by Ramsden, et al., column 1, lines 31-32).

25. As per claim 17, Kulik in view of Ramsden, et al. teaches the system of claim 14 as described above. Ramsden, et al. further teaches the software further includes instructions for storing transaction information for said mail piece in said memory (column 10, lines 8-9). The limitation "said transaction information including said determined postage amount and said final class of service" is a recitation of the non-functional descriptive material (i.e., transaction information) stored on the memory and is afforded no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *In re Gulack*, 703 F.2d 1381, 1385; 217 USPQ 401, 404 (Fed. Cir. 1983). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the software further includes instructions for storing transaction information for said mail piece in said memory into the system taught by Kulik in view of Ramsden, et al. in order to maintain a package history log (as taught by Ramsden, et al., column 10, line 42).

26. As per claim 18, Kulik in view of Ramsden, et al. teaches the system of claim 11 as described above. Ramsden, et al. further teaches the software further includes instructions for storing transaction information for said mail piece in said memory (column 10, lines 8-9). The limitation "said transaction information including said

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determined postage amount, said final class of service and said list of applicable special services" is a recitation of the non-functional descriptive material (i.e., transaction information) stored on the memory and is afforded no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *In re Gulack*, 703 F.2d 1381, 1385; 217 USPQ 401, 404 (Fed. Cir. 1983). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the software further includes instructions for storing transaction information for said mail piece in said memory into the system taught by Kulik in view of Ramsden, et al. in order to maintain a package history log (as taught by Ramsden, et al., column 10, line 42).

27. As per claim 19, Kulik in view of Ramsden, et al. teaches the system of claim 11 as described above. Kulik further teaches determining whether said first class of service supports said determined at least one parameter (column 8, lines 38-39; Tables 1-3) and, if not, finding a third class of service that supports said determined at least one parameter (column 8, lines 41-43; Tables 1-3); determining whether one of said first class of service and said third class of service, if applicable, supports said determined weight (column 8, lines 38-43; Tables 1-3) and, if not, finding a fourth class of service that support said determined weight (column 8, lines 45-46; Tables 1-3); setting said second class of service equal to said third class of service if said first class of service

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does not support said at least one parameter and said third class of service supports said weight (column 7, lines 21-23; column 8, lines 41-43; Tables 1-3); and setting said second class of service equal to said fourth class of service if neither of said first class of service and said third class of service, if applicable, support said determined weight (column 7, lines 21-23; column 8, lines 45-46; Tables 1-3); wherein said first class of service is appropriate if said first class of service supports said determined weight (column 7, lines 18-21; column 8, lines 38-39; Tables 1-3). Kulik further teaches that a dimension is a parameter, along with weight, that is used to determine appropriate classes of mail (column 5, lines 1-4).

28. As per claim 20, Kulik in view of Ramsden, et al. teaches the system of claim 19 as described above. Kulik further teaches determining said third class of service and said fourth class of service based on predetermined rules for switching classes (column 6, lines 44-45; Tables 1-3). Examiner is interpreting a rates manager with break points for each selected class as predetermined rules for switching classes.

Conclusion

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Thiel, U.S. Pat. No. 5,606,508 (Reference B of the attached PTO-892) teaches a system for franking postal matter comprising a control module, a printer module, a memory connected to the control module, a receiving device

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connected with the memory for receiving data transmitted via transmission device; with at least one table of data with information linked to one or more conditions are downloaded from the transmission device; wherein the control module storing the data in predetermined memory regions of the memory when the assembly is put into operation; and where a current table of data and information is selected from the data with specific functions to be available in the assembly for franking postal matter in dependence on the one or more conditions. Vogel, U.S. Pat. No. 5,914,464 (Reference C of the attached PTO-892) teaches a self-service device allowing postal customers to determine the postage fees for letters and small parcels has a weighing scale and also registers the thickness and format size of the mail piece in a simple manner; with a receiving chamber for the mail piece sits on the scale and contains sensors for acquiring the thickness and format information.


30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P. Vetter whose telephone number is (571) 270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on (571) 272-0847. The fax

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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


MATTHEW S. GART
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600


Daniel P. Vetter
AU #3628